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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/640,822	08/17/2000	Heinrich Gers-Barlag	Bei 637- KGB	6834

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EXAMINER

WELLS, LAUREN Q

ART UNIT PAPER NUMBER

1617

DATE MAILED: 06/17/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n No. 09/640,822	Applicant(s) GERS-BARIAG ET AL.
Examiner Lauren Q Wells	Art Unit 1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on 22 April 2002 and 15 February 2002.
- 2a)  This action is **FINAL**.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4)  Claim(s) 16-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 16-30 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a)  All    b)  Some \*    c)  None of:
1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other:

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### DETAILED ACTION

Claims 16-30 are pending. The Amendment received February 15, 2002, cancelled claims 1-15 and added claims 16-30.

#### *Request for Continued Examination*

The request filed on April 22, 2002 for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 09/640822 is acceptable and an RCE has been established. An action on the RCE follows.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) The term "finely disperse water-in-oil systems" in claim 16 (line 1) is vague and indefinite, as it is confusing. Are water-in-oil systems synonymous to water-in-oil emulsions? Is the invention directed to a water-in-oil emulsion? What is finely? Does it mean that the particles of the emulsions are in a specific size range? The specification does not define this term and one of ordinary skill in the art would not be apprised of its meaning.

(ii) The term "modified" in claims 16 (line 7), 20 (line 1), line 21 (lines 1-3), 23 (lines 1, 3), and 29 (line 1) is a relative term which renders the claim indefinite. The term "modified" is not defined by the claim, the specification does not provide a standard for ascertaining the

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requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

(iii) The phrase "characterized in that" in claims 17 (line 1), 18 (line 1), 19 (line 1), 20 (line 1), 21 (line 1), 22 (line 1), 23 (line 1), 26 (line 1), 27 (line 1), 28 (line 1), 29 (line 1) is vague and indefinite, as it is not clear whether the composition actually has the characteristics recited following this phrase.

(iv) The phrase "the water phase content is chosen from the range from 15-60% by weight" in claim 18 (lines 1-2) is vague and indefinite, as the Markush language is confusing. What is the Markush group? This rejection can be overcome by deleting the phrase "chosen from the range".

(v) The terms "microfine" and "micronized" in claims 23 (lines 3, 4) and 24 (line 1) are relative terms which render the claims indefinite. The terms "microfine" and "micronized" are not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

(vi) The term "polymer particles" in claim 23 (line 3) is vague and indefinite, as it is not clear what this term refers to. What makes a polymer a particle? Is Applicant intending to claim a size range of polymers?

(vii) Claim 25 is rejected for the use of improper Markush groups. See MPEP 2173.05(h) for examples of proper conventional or alternative Markush-type language (e.g., "... selected from the group consisting of... and ..."). The "or" terms in line 2 make the Markush group confusing.

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(viii) The terms "decorative stick" and "care lipstick" in claim 27 (line 3) is vague and indefinite, as it is not clear what these terms refer to. What is a decorative stick? How is a lipstick different from a "care" lipstick? The specification does not define these terms and one of ordinary skill in the art would not be apprised of them.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fanger et al. (6,153,204) in view of Msika et al. (5,939,054).

Fanger et al. teach cosmetic or pharmaceutical preparations with a reduced feeling of stickiness. The preparations are disclosed as emulsifier-free, water-in-oil lipodispersions. Lipsticks and deodorant sticks are disclosed as forms of the preparations. Aluminum silicates, such as bentonites are disclosed as thickeners for use in the preparations. Paraffin oils, castor oil, isopropyl myristate, vaseline, lanolin, beeswax, ceresin, ozokerite, carnauba wax, candelilla wax and others are disclosed as preferred oily substances. UVA and UVB filters, iron oxides, zinc oxides, antioxidants, and bactericides are disclosed as additional additives for use in the preparations. The reference lacks preferred modified hectorites and methods of preparing the emulsions.

Msika et al. teach water-in-oil sunscreen emulsions. Quaternium 14 and 18 hectorite are disclosed as gelling derivatives for use in the emulsions. Smectites and derivatives, magnesium

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and aluminum silicates are disclosed as powders that may be added to the emulsion. The fatty phase is disclosed as comprising 20-60% of the composition. Stick forms of the emulsions are disclosed. Emulsions comprising no emulsifiers are exemplified (see Col. 12, line 55).

Antioxidants, antimicrobials, and UV actives are disclosed as additives for use in the composition. Disclosed is a method of making the emulsion, wherein the aqueous phase is added to the fatty phase with slow stirring.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to exemplify the instant water-in-oil emulsions using the teachings of Fanger et al. because Fanger et al. teach emulsifier-free, water-in-oil emulsions comprising oily phase constituents that melt above 40 C and teach aluminum silicate (a phyllosilicate) as a thickener for use in the emulsion, wherein the emulsion can be in the form of a lipstick; hence, using the teachings of Fanger et al. to arrive at the instant invention would be within the skill of one in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the quaternium-18 hectorite of Msika et al. for the aluminum silicate in Fanger et al. because a) Msika et al. and Fanger et al. are both directed to water-in-oil emulsions for cosmetic use; b) Msika et al. and Fanger et al. both teach modified phyllosilicate pigment particles as gelling thickeners for use in their emulsions, wherein Fanger et al. teach montmorillonites of the bentone type, such as quaternium 14 and 18 hectorite, as thickeners, and Msika et al. teach bentonites (bentonites are aluminum silicates) as thickeners; c) Msika et al. teach quaternium 18 hectorite as optimizing the stability of water-in-oil emulsions and as potentiating the solar protection of emulsions; thus, because of the expectation of optimizing

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stability and solar protection, the replacement of one phyllosilicate for the other for cosmetic thickening purposes, would be within the skill of one in the art.

#### *Unexpected Results*

It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed; *In re Linder*, 173 USPQ 356 (CCPA 1972).

In the instant case, there are no unexpected results.


#### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on T-F (6-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
May 14, 2002

  
RUSSEL TRAVERS  
PRIMARY EXAMINER  
GROUP 1200